

Appln No. 09/880,634
Amdt date November 29, 2004
Reply to Office action of July 28, 2004

REMARKS/ARGUMENTS

In the Final Rejection dated July 28, 2004, the examiner rejects claim 1 under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent No. 5,753,387 to Takami, et al. in view of U.S. Patent Publication No. 2001/0051300 to Moriguchi, et al. Takami discloses a carbonaceous material with a "multi-phase structure having a region of graphite structure and a region of amorphous carbon structure." (Column 4, lines 64-67). In contrast, claim 1 is directed to a negative active material of a single phase, namely, of a crystalline carbon structure. See Specification p. 3, lines 2-4. The claim has been amended to clarify this feature by using the language "consisting essentially of." Because Takami fails to teach or suggest such a single phase carbon graphite structure, claim 1, as amended, is allowable over Takami.

Moriguchi fails to remedy the deficiencies of Takami, as Moriguchi also fails to teach or suggest the single phase carbon structure of the negative active material, as claimed in amended claim 1. As such, claim 1, as amended, is allowable over both Takami and Moriguchi.

The examiner also rejected claim 6 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over Takami. However, claim 6 depends from independent claim 1, which is now allowable over Takami. Accordingly, claim 6 is also allowable over Takami.

In the Advisory action dated November 8, 2004, the examiner refused to enter applicants' above described amendments. In refusing the enter these amendments, the examiner asserts that

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the replacement of the term "comprising" with the phrase "consisting essentially of" constitutes new matter. However, applicant submits that such an amendment is an acceptable way to narrow a claim to overcome a prior art rejection. See *The Regents of the University of California v. Eli Lilly and Company*, 119 F.3d 1559, 1573 (Fed. Cir. 1997) ("Lilly"); *Momentum Golf, Inc. v. Swingrite Golf Corp.*, 312 F. Supp. 2d 1134 (S.D. Iowa 2004) ("Momentum"); *Yoon Ja Kim v. Conagra Foods, Inc.*, 2003 U.S. Dist. LEXIS 5005 ("Conagra").

In *Lilly*, the court upheld the patentee's replacement of the term "comprising" with the phrase "consisting essentially of" to successfully overcome a prior art rejection. Similarly, in both *Momentum* and *Conagra*, the courts upheld the examiners' amendments replacing the term "comprising" with the phrase "consisting essentially of." Also, in *Momentum*, the court noted that the phrase "consisting essentially of" is commonly used and denotes the drafter's intention to limit the invention to the listed ingredients, while leaving the claim open only to "unlisted ingredients that do not materially affect the basic and novel properties of the invention." *Momentum*, 312 F.3d at 1140 (citing *PPG Industries v. Guardian Industries Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998)).

Furthermore, the specification at page 5, lines 20-27 describes the process by which the carbon precursor is crystallized. This description in the original specification, therefore, provides sufficient support for applicants' amendments.

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In light of the above remarks, applicants submit that all of pending claims 1 and 6, as amended, are in condition for allowance. A timely indication of allowance is therefore requested. However, if there are any remaining issues that can best be addressed by telephone, the examiner is asked to contact applicants' attorney at the number below.

Respectfully submitted,

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